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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,001	10/17/2001	John D. Doyle	EMPIR-030AUS	5503
22494	7590	01/20/2004	EXAMINER	
DALY, CROWLEY & MOFFORD, LLP SUITE 101 275 TURNPIKE STREET CANTON, MA 02021-2310			PHAM, TUAN	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 01/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,001

Applicant(s)

DOYLE ET AL.

Examiner

TUAN A PHAM

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Bold et al. (Pub.No.:2002/0021710, hereinafter "Bold").

Regarding claim 1, Bold teaches a method of providing a multiple interface system (see figure 2, col.2, [0036]) comprising the steps of:

providing a SDS module having a first physical interface (see figure 2, col.2, [0036]);

providing a T1/E1 module having a second physical interface, the second physical interface being different from the first physical interface (see figure 2, col.2, [0036]); and

sharing a resource from the T1/E1 module with the SDS module (see col.2, [0038]).

Regarding claim 2, Bold further teaches a method wherein SDS physical interface and the T1/E1 physical interface are selected from the group consisting of T1, E1 (see col.2, [0038]).

Regarding claim 3, Bold further teaches a method wherein the resource comprises a digital signal processor (DSP) (see col.2, [0036]).

Regarding claim 4, Bold further teaches a method wherein the T1/E1 module runs a protocol associated with the SDS module (see col.2, [0038]).

Regarding claim 5, Bold further teaches a method further comprising the step of providing a communications path between the SDS module and E1/T1 module (see col.2, [0036, 0038]).

Regarding claim 6, Bold further teaches a method further comprising the step of changing a configuration of the system from one associated with the SDS physical interface to one associated with the T1/E1 physical interface (see col.2, [0037]).

Regarding claim 7, Bold further teaches a method further comprising the step of making the interface channels appear contiguous (see figure 2, col.2, [0036]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bold et al. (Pub. No. :U.S.2002/0021710 A1, hereinafter "Bold") in view of Gregory, III et al. (U.S. Patent No. 5,793,415, hereinafter, "Gregory").

Regarding claim 8, Bold further teaches a method of providing a multiple interface system (see figure 2, col.2, [0036]) comprising the steps of:

providing a SDS module having a first physical interface (see figure 2, col.2, [0036]);

providing a T1/E1 module having a second physical interface, the second physical interface being different from the first physical interface (see figure 2, col.2, [0036]); and

sharing a resource from the T1/E1 module with the SDS module (see col.2, [0038]).

It should be noticed that Bold fails to clearly teach a method wherein at least one of the first module and the second module comprise an audio enable module. However, Gregory teaches such features (see col.7, ln.50-67) for a purpose of providing the audio signals for the system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a method wherein at least one of the first module and the second module comprise an audio enable module, as taught by Gregory, into view of Bold in order to monitor the audio signal in T1/E1 interface at the same time.

Regarding claim 9, Gregory further teaches a method wherein the first module and the second module utilize pulse code modulated audio streams (see col.6, ln.1-29).

Regarding claim 10, Gregory further teaches a method wherein the PCM audio stream comprises an audio stream selected from the group comprising Mu-law encoded audio and a-law encoded audio (see col.6, ln.1-29).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Cantwell et al. (U.S. Patent No. 6,370,155), Cowgill (U.S. Patent No. 5,835,566), and Buckland et al. (U.S. Patent No. 6,618,374) are not applied into this Office Action, they are also called to Applicants attention. They may be used in future Office Action(s). These references are also concerned for supporting the system and method for providing in-band and out-band testing of telecommunication network components and high density unit shelf network interface card.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (703) 305-4987 and E-mail address is: **tuan.pham@USPTO.GOV**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and

IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.

Any response to this action should be mailed to:

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Washington, D.C. 20231

Or faxed to:

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(703) 872-9306

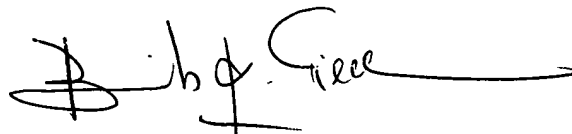
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

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Date: January 7, 2004

Examiner

Tuan Pham



BINH TIEU
PRIMARY EXAMINER